



8-2-7

AF
v

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Curtiss et al.

Serial No.: 09/120,970

Filed: July 22, 1998

Entitled: RECOMBINANT BACTERIAL
VACCINE SYSTEM WITH
ENVIRONMENTALLY LIMITED
VIABILITY

ART UNIT: 1645

EXAMINER: PORTNER, Virginia A.

Attorney Docket No.: MEG-207.0 US-1

Mail Stop Appeal Brief-Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

TRANSMITTAL LETTER

Sir:

Transmitted herewith: [X] A Reply Brief pursuant to 37 C.F.R. §41.41 (3 pages); and [X] a return-receipt postcard, for filing in the above-captioned patent application.

FEE FOR ADDITIONAL CLAIMS

[X] A fee for additional claims is not required.

[] A fee for additional claims is required. The additional fee has been calculated as shown below:

	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	NUMBER OF EXCESS CLAIMS	RATE	FEES DUE
TOTAL CLAIMS	==	==	00	× \$25	= 0.00
INDEPENDENT	=	=	0	× \$100	= 0.00
FIRST INTRODUCTION OF MULT. DEPENDENT CLAIM				+\$180	= 0.00
TOTAL FEES DUE					= 0.00

PAYMENT OF ADDITIONAL FEES

- ☐ A check including the amount of \$_____ in payment of the fees for filing a brief in support of an appeal under 37 C.F.R. §41.37 is enclosed.
- ☒ The Commissioner is hereby authorized to charge payment of any additional fees required under 37 CFR 1.16 or 1.17 in connection with the paper(s) transmitted herewith, or to credit any overpayment of same, to Deposit Account No. 50-0268. A duplicate copy of this transmittal letter is submitted herewith.

PETITION FOR EXTENSION OF TIME

- ☐ Extension is requested under 37 CFR 1.136(a), and the following extension fee is applicable for the Response filed herewith:
- ☐ \$60.00 for response within first month pursuant to 37 CFR 1.17(a)(1);
 - ☐ \$225.00 for response within second month pursuant to 37 CFR 1.17(a)(2);
 - ☐ \$510.00 for response within third month pursuant to 37 CFR 1.17(a)(3);
 - ☐ \$795.00 for response within fourth month pursuant to 37 CFR 1.17(a)(4);
 - ☐ \$1,080.00 for response within fifth month pursuant to 37 CFR 1.17(a)(5).
- ☐ A check including the amount of ☐ \$60.00 ☐ \$225.00 ☐ \$510.00 ☐ \$795.00 ☐ \$1,080.00 in payment of the extension fee is transmitted herewith.
- ☒ The Commissioner is hereby authorized to charge payment of any additional fees required in connection with the paper(s) transmitted herewith, or to credit any overpayment of same, to Deposit Account No. 50-0268. A duplicate of this transmittal letter is submitted herewith.

Respectfully submitted,



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CERTIFICATE OF MAILING BY "EXPRESS MAIL"

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August 1, 2007

 date



 Melanie A. McFadden



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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REPLY BRIEF

Sir:

Pursuant to 37 C.F.R. §41.41, this Reply Brief is filed in response to the Examiner's Answer mailed June 1, 2007.

No fees are believed to be due; however, the Commissioner is authorized to charge any additional fees required in connection with the papers filed herewith to Deposit Account No. 50-0268.

Grounds for rejection 1 (lack of enablement)

In section 9, paragraph 1, of the Examiner's Answer, the Examiner repeats the grounds of rejection for lack of enablement of Claims 61-64, which refer to a particular plasmid, pMEG-104, that embodies the invention and for which a Budapest Treaty deposit is deemed to be required for enablement under 35 U.S.C. §112.

This issue was omitted in Appellants' corrected Appeal Brief filed January 23, 2007, which apparently has not been considered by the Examiner: It is noted that the Examiner's Answer refers to the original Brief on Appeal filed November 14, 2006.

In a communication mailed December 20, 2006, filing of a corrected Brief was required in order to maintain the appeal. Appellants duly filed a Corrected Brief on Appeal on January 23, 2007. In their Corrected Brief, Appellants, *inter alia*, provided a copy of the deposit receipt evidencing deposit of the microorganism designated MGN-417 (which harbors the plasmid pMEG-104 mentioned in the appealed claims) under the terms of the Budapest Treaty, with the American Type Culture Collection (ATCC), Rockville, MD 20852. Further, pursuant to 37 C.F.R. §1.808, Appellants, through their undersigned attorney of record, declared that all restrictions upon public access to the deposit will be irrevocably removed upon the grant of a patent on this application and that the deposit will be replaced if viable samples cannot be dispensed by the depository. See, page 14 of the Corrected Brief on Appeal and the Evidence Appendix (tab B) appended thereto.

In view of the foregoing, these grounds for rejection are believed to be moot and should be withdrawn from this appeal.

Grounds for rejection 2 (obviousness-type double patenting)

In section 9, paragraph 2, of the Examiner's Answer, the Examiner repeats the grounds of rejection applied to Claims 30, 32, 33, 35-38, 39, and 50-60 alleging obviousness-type double patenting over the subject matter of Claims 1-24 of U.S. Patent No. 6,780,405.

This issue is dealt with at pages 6-13 of Appellants' Corrected Brief on Appeal.

Although the Examiner makes reference to the claims of U.S. Patent No. 6,780,405, all arguments of the Examiner's Answer quote from the specification of the patent, and there is no comparison between the subject matter of the '405 patent claims with the rejected claims on appeal here. This is error. See, MPEP §804(II)(B)(1). See, also, *In re Longi*, 225 USPQ 645, 648 (Fed. Cir. 1985) (citing *Carman Industries Inc. v. Wahl*, 220 USPQ 481, 487 (Fed. Cir. 1983)); *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 U.S.P.Q.2d 1839, 1846 (Fed. Cir. 1992).

The Examiner's argument, comparing what is presently claimed with *what is discussed in the '405 patent specification but is not claimed* is improper as a matter of law and cannot sustain an obviousness-type double

patenting rejection. Any disclosed but unclaimed embodiments in the specification of the '405 cannot support an obviousness-type double patenting rejection because the specification of the '405 patent is not prior art against the application on appeal. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, op.cit. (Fed. Cir. 1992).

Accordingly, for the reasons set forth in detail in Appellants' Corrected Brief on Appeal, the rejection of appealed Claims 30, 32, 33, 35-38, 39, and 50-60 for obviousness-type double patenting in view of any subject matter *claimed* in U.S. Patent No. 6,780,405 is incorrect and should be reversed.

Respectfully submitted,




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